

REMARKS

Claims 1-9, 17, 19 and 31- 34 are presently pending in the application. By this amendment, previously pending claims 20-21 have been cancelled without prejudice to reintroducing them, for example in a continuation application. New claims 31-34 have been added. Claims 10-16, 18 and 22-30 were previously withdrawn pursuant to a restriction requirement. Reexamination and reconsideration of the application in view of the following remarks are respectfully requested

Claims 1-9, 17 and 19-21 were rejected by the examiner under 35 U.S.C. 102(b) as being anticipated by Lafferty et al. (U.S. Patent 5,188,093). According to the examiner, Lafferty et al. disclose all the recited elements of claims 1-5, 8, 9, 17, and 19-21.

Without agreeing that the elements of the claims 1-9, 17, and 19-21 are disclosed by Lafferty, Applicants have nevertheless amended claim 1 to clarify its currently claimed invention by explaining that proximal portion of an elongated shaft having "a substantially constant outer diameter," and also to recite a ferrule having a proximal portion with a "substantially constant outer" diameter, "the outer diameter being substantially the same as the outer diameter of the elongated shaft proximal portion."

Applicants have similarly amended claim 17 to require the same structural relationship between the ferrule proximal portion diameter and the shaft proximal portion diameter, that is, that they be substantially constant and substantially the same.

Support for these amendments is found in the figures, for example Figs. 2b and 2d, and also in the specification at paragraph 106 which recites that "[i]n embodiments of the invention, the outer diameter of proximal portion 40 of ferrule 22 is configured to closely match the outer diameter of hypotube 18 effective to provide a substantially continuous external surface." As explained in the specification, for example at paragraph 11, the optical instrument of the present invention "may be used in therapeutic mode as guiding rails to guide other instruments (such as e.g. catheters) to a desired location within a patient's body, or in optical mode to receive or transmit optical radiation within a patient's body." It will therefore be appreciated that when used in therapeutic mode as a guidewire it may be desired to slide some intracorporeal device

over the elongated shaft for delivery. Clearly, a substantially continuous external surface between ferrule and elongated shaft will facilitate such purpose.

It is respectfully submitted that Lafferty does not teach all the limitations of independent claim 1 or independent claim 17, as presently amended, and therefore, these claims are allowable and should be passed to issue.

Accordingly, because claims 2-9, and 31-32 depend from the allowable claim 1, and claims 19 and 33-34 depend from the allowable claim 17, it is respectfully submitted that for this reason alone dependent claims 2-9, 19 and 31-34 are also in condition for allowance and that they be passed to issue.


CONCLUSION

In view of the above amendments and remarks, Applicants respectfully request that claims 1-9, 17, 19 and 31-34 be allowed and the application be passed to issue. Any fee that may be due, or any refund that should be credited, may be charged to Deposit Account No. 06-2425.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

Date: May 19, 2005

By: 
David J. Pitman
Registration No. 48,777

DJP:mmm
Enclosure

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201